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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,115	09/19/2003	Russell Norman Mirov	SUN03-0112	8531
57960 7590 07/09/2008 PVF -- SUN MICROSYSTEMS INC. C/O PARK, VAUGHAN & FLEMING LLP 2820 FIFTH STREET DAVIS, CA 95618-7759				
EXAMINER				
DINH, TUAN T				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/667,115

**Applicant(s)**

MIROV, RUSSELL NORMAN

**Examiner**

Tuan T. Dinh

**Art Unit**

2841

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,34-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Noted: The term “**configured to**” performs a function, which is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3, 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, lines 8-9, it is unclear. The phrase of “wherein the mechanism is configured to be detached by breaking the substrate in the specific area” is not understood. Does applicant mean of “the mechanism is configured to be detached by breaking at the specific area of the substrate?”

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-7, 34-36, and 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Matson et al. (U.S. Patent '112) as in the record.

As to claims 1-3, Matson discloses a circuit board (12, column 2, line 7) as shown in figures 1-2 comprising: a substrate which includes a specified area of the substrate that is used as a mechanism (16, column 2, line 9) comprising:

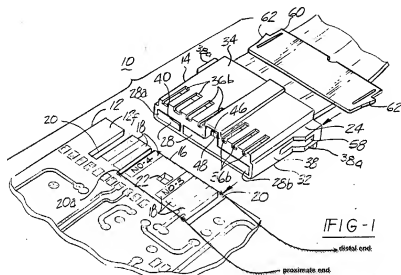
signal means for (wire traces 18, and circuitries formed in/on the circuit board 12) conducting a signal between the mechanism (16) and the circuit board (12); and

separation means (gaps 20, column 2, line 15) for facilitating detachment of the mechanism (16) from the circuit board (12) wherein the mechanism (16) is configured to be detached by breaking the substrate at the specified area (the mechanism adapted to be broke then the circuit board being broke then the circuit board cannot be used anymore);

identification means for (labels No.1-No.6, figure 1 shows the label No.3 and No.4) identifying the mechanism (16);

wherein the circuit board becomes at least partly non-functional if the mechanism is detached from the circuit board.

As to claims 5-7, Matson discloses in figure 1 the identification means being a circuit (conductor run (18), visible identification code (labels No. 3, No. 4), and being protected (by a molded connector 14) from being easily manipulated.



As to claims 34, 40-41, Matson discloses a circuit board assembly, shown in figure 1 comprising:

a circuit board (12) comprising a substrate including **a specified area that is used as a tab** (key tab-16), wherein the tab (the specific area 16) comprising: proximate and distal ends (see figure above); and two opposing sides separated from the assembly by gaps (slots 20); an identification (labels NO.1-No.6 formed on conductor runs 18 to identify the function of leads/pins of the conductor runs) situated on the tab (16); and

a signal conductor (traces or wirings on the board) extending from the circuit board to the tab and configured to convey a signal when the assembly is powered; wherein the tab is configured to (adapted to or intended used) to be removed BY BREAKING the specific area of the substrate, and wherein removal of the tab (breaking the specific area of the substrate) from the circuit board assembly causes said portion of

the signal conductor to be not electrical contact to the assembly, and wherein after the mechanism (16) has been detached from the circuit board (note: the mechanism being broken (that means to open circuit)), the mechanism cannot be reattached (when the mechanism or key or tab being broken (to be open circuit)) to the circuit board, wherein the only way to detach the mechanism is so detach the mechanism from the circuit board so that the mechanism cannot be reattached to the circuit board (so after the mechanism detached from the circuit board in condition of broken then the mechanism cannot be reattached back to the circuit board).

As to claim 35, Matson discloses the circuit board assembly cannot be powered if the signal conductor on the tab is decoupled (it is inherently that if one of the trace or wiring being broken or damage then the board cannot be operated).

As to claim 36, Matson discloses one or more operating functions of the circuit board become inoperable when the signal conductor is broken.

As to claim 39, Matson discloses the identification module comprises a sequence of characters (labels).

As to claim 42, Matson discloses the signal conductor (traces) does not extend to the distal end of the tab (16).

As to claim 43, Matson discloses a circuit board assembly as shown in figures 1-2 comprising:

- a substrate which includes:

- a signal conductor (18); and

a specified area of the substrate that is used as a key (16) removably connected to the circuit board assembly and comprising: an identification (labels); and

a portion of said signal conductor (the key including a portion of the conductors 18 and labels formed on the conductors); wherein the key is configured to be (adapted to be or intended to be) removed BY BREAKING the substrate at the specified area;

wherein while said key is removably connected to the circuit board assembly (the assembly is condition of breaking circuit) a plurality of gaps (20, see figure 2) are defined between the circuit board assembly and said key; and wherein removal of the key (BREAKING SUBSTRATE) from the circuit board assembly causes said portion of the signal conductor on the key to be decoupled (to be not electrical contact) to the assembly.

As to claim 44, Matson discloses a circuit board as shown in figures 1-2 comprising:

a substrate which includes a specified area that is used as a key (16)

the key (16) removably connected to the circuit board, the key comprising: a portion of a signal conductor (18) configured to conduct a signal between the key and the circuit board; and an identification (labels) configured to identify the key; wherein the key (16) is configured to be removed BY BREAKING the substrate at the specified area

wherein the key is removably connected to a first portion of the circuit board but is separated from other portions of the circuit board by a plurality of gaps (20); wherein the gaps facilitate detachment of the key from the circuit board; and wherein one or more functions of the circuit board become at least partly non-functional, including

conduction of a signal by the signal conductor (18), if the key is detached from the circuit board (it is inherently that cause the signal line/trace/wiring being non functional when the conductor signal not connected to the assembly).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matson ('112).

As to claims 37-38, Don discloses all of the limitation of the claimed invention, except for the identification comprises a hologram or barcode.

However, the barcode or hologram is well known in the art that provide an identification or logo for the product. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a barcode or hologram to modify the labels as taught by Matson for the purpose of verifying or identification product.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-3, 4-7, and 34-44 have been considered but are moot in view of the new ground(s) of rejection.



Applicant argues:

“There is nothing in Matson which suggest a circuit board which includes a substrate that includes a specified area of the substrate that is used as a mechanism for provably disabling the circuit board, wherein the mechanism is configured to be detached by breaking the substrate in the specified area. Thus, Matson does not anticipate the claimed invention. “

Examiner disagrees. Matson in figure 1 that shows the specified area that included the key/tab or mechanism (16), which output end of the conductors (18), so, the tab/key or mechanism **is configured to be detached or removed** BY BREAKING the specified area of the substrate that is equivalent to breaking the conductors on the substrate or board (12) then when the circuit board or substrate is in condition of breaking circuit then the substrate does not work.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T. Dinh whose telephone number is 571-272-1929. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reichard Dean can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tuan T Dinh/  
Primary Examiner, Art Unit 2841.